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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,350	01/14/2004	Christopher Yao Wen Chen	PATH-002	5286
30139	7590	10/04/2007	EXAMINER	
WILSON & HAM			SMITH, CREIGHTON H	
2530 BERRYESSA ROAD				
PMB: 348				
SAN JOSE, CA 95132				
			ART UNIT	PAPER NUMBER
			2614	
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			10/04/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/758,350

**Applicant(s)**

CHEN ET AL.

**Examiner**

Creighton H. Smith

**Art Unit**

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>11.06.04, 06.10.06</u> | 6) <input type="checkbox"/> Other: ____  |

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, 10-15, 24-27, 33, 34 are rejected under 35 U.S.C. 102(E) as being anticipated by Kikinis- U.S. Patent Publication #2001/0043589.

Kikinis discloses in ¶-0021 a method of connecting and placing COST (Connection Oriented Switched Telephony calls) to a bridging unit; connecting a data network line to a data network port for receiving and placing Data Network Telephony (DNT) calls on a data network; receiving a 1<sup>st</sup> call from one of the COST network and data network; placing a 2<sup>nd</sup> call associated with the 1<sup>st</sup> call on the network other than the network on which the 1<sup>st</sup> call is received; and dynamically converting data between the 2 associated calls and thereby providing a continuing and dynamic telephony connection between a COST telephone connected to the COST network and a DNT terminal connected to the DNT network. In the Abstract, 3<sup>rd</sup> sentence from the end, Kikinis discloses that the data network can be the Internet (packet-switched network) and the COST network can be any switched dedicated-connection-oriented telephone network.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5, 7, 16, 18, 19, 28, 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kikinis in view of Chen et al, U.S. Patent # 7,092,380 .

Chen et al disclose in col. 5, lines 38-41 that Internet phone (16) sends an IP address and identification code to server 36. To have similarly provided in Kikinis the teaching by Chen et al of transmitting a code representing an IP address would have been obvious to a person having ordinary skill in the art because both references are teaching telephone calls between the PSTN and Internet. For claim 7, Chen et al disclose DTMF in col. 8, lines 45-56.

Claims 6, 17, 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kikinis in view of Chen et al as applied to claims 4 above, and further in view of Verma et al, U.S. Patent Publication #2003/0224792

Verma et al disclose that a node will listen for "advertisement" messages from other routers in col. 1, lines 63 et seq. To have provided Verma et al teaching of providing "advertisements" in Kikinis' teaching would have been obvious to a person having ordinary skill in the art because both references are teaching phone calls between 2 different networks and the skilled practitioner would have used common sense in combining these 2 references.

Claims 8, 20, 31, are rejected under 35 U.S.C. 103(a) as being unpatentable over Kikinis in view of Reding et al, U.S. Patent Publication #2005/0105510

Reding discloses in ¶-0036 that a telephone call may be made in either the PSTN or VoIP network, and discloses a screen in ¶-0147 that a server (416) may determine

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whether or not the caller-id information is on an acceptance list. To have similarly used Reding et al teaching of using caller-id to determine whether a caller is on a subscription list in Kikinis' apparatus would have been obvious to a person having ordinary skill in the art because acceptance lists in telephony using caller-id is old and well known.

Claims 9, 21, 32, are rejected under 35 U.S.C. 103(a) as being unpatentable over Kikinis in view of Reding et al as applied to claim 8 above, and further in view of Fogel, U.S. patent Publication #2005/0143054.

Fogel discloses in ¶-0057, last sentence, that if a calling party does not appear in any of the user's lists, the ring tone will adapted to vocalize a distinctive ring tone. To have similarly provided Fogel's teaching of a distinctive ring tone into Reding et al apparatus would have been obvious to a person having ordinary skill in the art.

Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kikinis in view of Mercuriali, U.S. patent Publication #2003/0179753.

Mercuriali discloses an adapter (48) that is "associated", i.e., coupled to, with a telephone (47), Fig. 1 and ¶-0027. To have similarly provide Mercuriali's teaching of having a routing device coupled to a telephone in Kikinis would have been obvious to a person having ordinary skill in the art because that practitioner would readily realize the portability routing device.

Any inquiry concerning this communication should be directed to Creighton H. Smith at telephone number 571/272-7546.

26 SEP '07



**CREIGHTON SMITH  
PRIMARY EXAMINER**